

copies of the two earlier PTO-1449 forms along with copies of the certificates of mailing and return postcards showing receipt by the PTO. In view of the large number of references, replacement copies are not enclosed herewith. Applicants would appreciate it if the Examiner would provide initialed copies of these forms with the next communication. If, for some reason, the references were not considered and the Examiner needs a copy of the cited references, the Examiner is urged to call the undersigned attorney and replacement copies will be provided on an expedited basis.

Reconsideration of this Application is respectfully requested in view of the discussion during the interview and the remarks set forth herein. This Amendment is responsive to the Office Action dated November 21, 2000. Claims 1-43 are pending. Claims 1-4, 9-18, 20, 22-38 and 40 have been rejected under 35 U.S.C. §103(a) over Fleming, U.S. Pat. No. 5,953,710 ("Fleming") and Sugimori, U.S. Pat. No. 6,047,265 (Sugimori). Claims 5-8, 19, 21, and 41-43 Claims have been rejected under 35 U.S.C. §102(e) as anticipated by Fleming. Claim 39 has been rejected under 35 U.S.C. §102(e) as anticipated by Sugimori.

As will be set forth in greater detail below, all the rejections are respectfully traversed and allowance of all the claims is respectfully requested.

To assist the Examiner in considering the remarks below, a brief discussion of the Fleming and Sugimori references is provided.

In general, Fleming describes an arrangement whereby a parent can supervise credit usage by a child. Both the child and the parent are provided with physical cards (see ref. numerals "2" and "4" of Figs. 1, 3 and 4, col. 4, lines 56-59, and col. 5, lines 40-42). Although the parent and child have individual account numbers, the accounts are inextricably linked. This is plainly evident from the fact that an increase in the child's available credit causes a decrease in

the parent's credit by an identical amount (see, e.g. col. 10, lines 45-47). Moreover, the child's card is no longer valid if the parent's card becomes invalid (col. 5, lines 45-51).

In general, Sugimori involves providing of a gift of a digital commodity, like a picture, news item, program, etc. that can be transferred digitally in encrypted form (col. 1, lines 21-22 and Fig. 6) and provision of a key that allows the recipient to decrypt the gifted commodity.

With that backdrop, it is respectfully submitted that neither reference anticipates any pending claim and that no combination of the two patents render the present claims obvious.

#### The Obviousness Rejections

As a general matter, the obviousness rejections are traversed because they do not follow the MPEP requirements for an obviousness rejection. The MPEP at §§ 2141-2143.03 sets out that a proper obviousness rejection must show “the three basic criteria” of a *prima facie* case: (1) motivation to combine or modify the references to the specific combination of elements recited in the claims, (2) reasonable expectation of success, and (3) every element of the claim shown in the art. It is respectfully submitted that none of the three are satisfied.

The MPEP identifies three permissible sources for motivation to combine references. First, the suggestion may come expressly from the references themselves. Second, it may come from knowledge of those skilled in the art that certain references, or disclosures in the references, are known to be of special interest or importance in the particular field. Third, it may also come from the nature of a problem to be solved, an identifiable aspect of a narrowly-defined and recognized problem that leads inventors to look to references relating to possible solutions to that problem. None of the three are present here.

There is nothing in the Fleming or Sugimori references themselves that suggests the combinations set forth in any pertinent paragraph of the Office Action. Each reference teaches a

complete embodiment, without a “loose end” in search of an improvement drawn from the other, or an advantage that suggests application to the other. Indeed, the two are in all respects complementary in that each can be used with the other, as described, without any modification to either. The only meaningful combination of the two would involve purchases of digital commodities using a Sugimori type arrangement by children (or parents) using a credit card governed by a Fleming type arrangement.

There is also no indication in the record, nor information known to Applicants, that either reference has attained the status of a standard reference work known to be of special interest to those of skill in the art.

Additionally, the rejections identify no narrow problem that would satisfy the “nature of the problem to be solved” prong of motivation to combine which would suggest the particular combinations set forth in the Office Action. Indeed, the two references are directed to significantly different problems. Fleming is directed to allowing a child to have a charge card that can be controlled by a parent and Sugimori is directed to giving a gift of a digital commodity item that can be purchased using a credit card.

Failing satisfaction of the above, there is no motivation available in the prior art to combine the two references, particularly in the manners posited by the Office Action.

The Office Action also repeatedly states, in rejecting various claims, that it would have been obvious to combine Fleming and Sugimori; relying upon statements of motivations not in any of the prior art of record. The Office Action does not provide a statement from the prior art which provides the cited motivation to combine the references as stated or that any modification necessary for combining the two as posited was known to be desirable: for instance, some statement in the prior art that "gifting of charge accounts from one party to another using the

"Internet" is desirable, as proposed in the Office Action. Failing such an express statement, it is again respectfully submitted that the two references are essentially complementary.

The Office Action has also not provided any statement in the prior art that would provide a reasonable expectation of success for any such modification (MPEP § 2143.02): for instance, that it is possible to modify Fleming and/or Sugimori to accomplish "gifting of charge accounts from one party to another using the Internet" without significantly changing either or both in a manner that would not render one or both no longer suitable for its described purpose.

Finally, the Office Action has not provided evidence that all elements of the claims (MPEP § 2143.03) are in the prior art. Specifically the Office Action does not cite any prior art having an element involving providing a credit, debit or charge account to a party who will use the account, "without both the issuance and provision of a physical card" to the party as recited in several of the claims. If these statements are found in the prior art, specific citation is respectfully requested. If these statements are not found in the prior art, then the claims must be allowed.

Turning to the individual rejections, since all the rejections suffer from the above problems, each rejection is treated only briefly with reference to the paragraph numbering in the Office Action.

Paragraph 4 of Office Action cites "Fig. 1/1/4 [sic]" of Fleming as basis for "without both the issuance and provision of a physical card for the charge account to the second party, the first party and the second party being different from each other" (emphasis supplied). However, Figs 1, 3 and 4 specifically refer to credit card "2 or 4" which are specifically identified as physical cards at Fleming, col. 4, lines 56-59.

Additionally, paragraph 4 of the Office Action states, with reference to Sugimori, that Sugimori sends an e-mail "directing the second party to perform a specified action to cause an activation of the account, activating the account for usage by the second party according to the account parameter (col. 1, lines 49-59)." However, Sugimori does not transfer accounts, nor does it mention account activation or account parameters. Applicants are unable to ascertain where in the cited passage (or elsewhere in Sugimori) such subject matter appears.

The Office Action (paragraph 4) further states that it would be obvious to combine Fleming and Sugimori as set forth and "The motivation for this is to teach a system providing for the gifting of charge accounts from one party to another using the Internet." As noted above, none of the art of record teaches or suggests any such combination of Fleming and Sugimori and thus, it is respectfully submitted that the only "obvious" combination of the two involves the complementary arrangement set forth above, i.e. where a "Fleming type" card is used to make a "Sugimori type" purchase.

Withdrawal of the rejection of paragraph 4 is requested.

As to paragraph 5, contrary to the statement in the Office Action, Sugimori does not "gift the charge account" or provide a world wide web interface for doing so. Additionally, for the reasons set forth above, it is respectfully submitted that the Examiner has not made out a *prima facie* case of obviousness because the prior art lacks any teaching, suggestion or motivation to combine Fleming and Sugimori to achieve the claimed invention. Withdrawal of the rejection of paragraph 5 is requested.

As to paragraphs 6-7, those paragraphs relate to dependent claims which are allowable based upon the allowability of claim 1. Withdrawal of the rejections of paragraphs 6-7 is requested.

As to paragraphs 8-17, those paragraphs relate to dependent claims which are allowable based upon the allowability of claim 5 discussed in "The Anticipation Rejection" section at page 9. Additionally, the claims referred to in those paragraphs are allowable in their own right. For example, in paragraph 13, the Office Action equates the "online portion" and "offline portion" in the claim to Figs. 2(c)(d)(e)(f) and 3 of Sugimori. However, as presently understood, the cited portions are all "online" since they illustrate client-server interactions. Similarly, in paragraph 14, all communications in Fig. 2 of Sugimori involve the same medium, e.g. computers transferring digital data.

Moreover, for the reasons set forth above, it is respectfully submitted that the Examiner has not made out a *prima facie* case of obviousness in those paragraphs because the motivations cited in the Office Action lack a basis in the prior art. The prior art lacks any teaching, suggestion or motivation to combine Fleming and Sugimori in a manner which would achieve each claimed invention.

Withdrawal of the rejections of paragraphs 8-17 is requested.

As to paragraph 18, the Office Action cites col. 3, lines 5-26 of Fleming as teaching the making an instrument of a purchaser selectable value available for purchase online by a first person in a name of a second person a purchase of which will result in the maintaining of a payment card account associated with the second person although no physical card is both issued for the account and provided to the second person at a time when the second person uses the payment card account. It is respectfully submitted that there is no mention anywhere in Fleming, including the cited portion, of: (a) making an instrument of a purchaser selectable value available for purchase online by a first person in a name of a second person -- Fleming creates a supervised charge account for a child, there is no purchase of an instrument (or charge account)

in Fleming; (b) a purchase of which will result in the maintaining of a payment card account associated with the second person -- since nothing is purchased in Fleming, that purchase can not "result in" maintaining of a payment card account; or (c) no physical card is both issued for the account and provided to the second person at a time when the second person uses the payment card account -- Fleming provides physical cards to both the parent and child.

Withdrawal of the rejection of paragraph 18 is requested.

Paragraphs 19-25 relate to dependent claims which are allowable based upon the allowability of claim 22. Additionally, the claims referred to in those paragraphs are also allowable in their own right. For example, paragraph 21 of the Office Action attributes to col. 5, line 60 - col. 6, line 5 of Sugimori disclosure of "executing a process which will construct a transfer instrument according to a template selected by the first person." However, Sugimori does not relate in any way to "transfer instruments" of the present invention. Similarly, paragraph 25 of the Office Action cites col. 7, lines 10-11, and 31-33 and Fig. 2A element 54, as disclosing "providing redemption instructions to the second person." Lines 10-11 state, "When a child makes an expenditure, a new debit transaction record 52 is created in the child's credit account." Lines 31-33 state, "The child statement list 54 is defined to include only transactions made by the individual child." Neither passage has anything to do with redemption.

Withdrawal of the rejections of paragraphs 19-25 is requested.

As to paragraph 26, the Office Action cites Fleming col. 5, lines 12-13 as teaching "without presentment of the physical card." Lines 10-13 however, state exactly the opposite -- "The parent's physical credit card 2 is used by the parent to make purchases by presenting the card to a merchant. [lines 10-11] Similarly, the child's credit card 4 is used to make purchases by

presenting the card to a merchant [lines 12-13]." Withdrawal of the rejection of paragraph 26 is requested.

Paragraph 27 of the Office Action states that col. 1, lines 39-59 of Sugimori "teaches no physical card for the credit card account being both issued and provided to the first party at the time the purchase is made using the account." The cited passage does not appear to relate in any way to a credit card account or physical card. Moreover, this paragraph is inconsistent with paragraph 4, since this is the only citation of Sugimori in paragraph 27. Withdrawal of the rejection of paragraph 27 is requested.

The rejections of paragraphs 28-35 each also suffer from the same defects noted above with respect to the "no physical card" aspect, absent from both Fleming and Sugimori, as well as the "motivation to combine" problems noted above. Withdrawal of the rejections of paragraphs 28-35 is requested.

#### The Anticipation Rejections

Anticipation requires that every aspect of the claim, in its *verbatim*, be expressly or inherently disclosed in the cited reference or the claim is not anticipated.

In paragraph 37 of the Office Action, there is a citation to Fleming for every aspect of the claim except "the gift certificate being an indication of a charge account but without both an issuance and provision of a physical card for the charge account or provision of a presentable gift certificate to the second party." It is respectfully submitted that, irrespective of whether any of the other elements of the claim correlate to the portions of Fleming cited in this Office Action paragraph, the portion quoted above appears nowhere in Fleming. Accordingly, withdrawal of the anticipation rejection of paragraph 37 is requested.

Paragraphs 38-45 each relate to a claim dependent from claim 5, which was rejected in paragraph 37. Accordingly, since claim 5 is not anticipated for the reasons set forth in the immediately preceding paragraph, those claims depending from claim 5 treated in paragraphs 38-45 of the Office Action are similarly not anticipated. Moreover, paragraphs 43-45 have further problems. For example, paragraphs 43-45 each cite Fleming for disclosure of a "gift certificate", yet neither the words "gift" or "gift certificate" nor the concept of a gift certificate appears anywhere in Fleming -- Fleming relates to a parents control of a child's credit card. Similarly, there is no disclosure in Fleming of "the gift certificate being an indication of a charge account but without both an issuance and provision of a physical card or provision of a presentable gift certificate to the second party." Recognition of this absence is evident from a lack of citation in the Office Action for these three points. Withdrawal of the anticipation rejections of paragraphs 38-45 is requested.

Finally, in paragraph 39, Sugimori, col. 1, lines 39-59, is credited as disclosing "data which will allow a person to make a purchase, using a payment card account indicated by the record, as if the payment card account had an associated physically presentable card in a name of the person even though, at or before a time when the payment card account is used to make the purchase, no physical card will have been both issued and physically provided to the person." As noted above, Sugimori does not even relate to payment card accounts, let alone disclose the person having no physical card "at or before a time when the payment card account is used to make the purchase". Withdrawal of the anticipation rejection of paragraph 39 is requested.



**CONCLUSION**

It is respectfully submitted that, as shown above, neither of the applied references disclose certain aspects attributed to them. Accordingly, it is respectfully submitted that the rejections of claims 1-43 must be withdrawn, the claims should all be allowed and the application be passed to issue in due course. The Examiner is urged to telephone Applicants' undersigned counsel at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance.

Although no extension of time is believed necessary, in the event that an extension of time is required, Applicants hereby petition for such extension of time required to make this response timely. In the event any fee is due for consideration of this Response, kindly charge any such fee, or credit any surplus, to Deposit Account 13-4500, order number 3606-4000.

Respectfully submitted,

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